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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,903	03/31/2000	CHRISTINE DUPUIS	05725.0532	7762

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FINNEGAN HENDERSON FARABOW
GARRETT & DUNNER
1300 I STREET NW
WASHINGTON, DC 20005

EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 03/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/485,903

Applicant(s)

DUPUIS ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 18-45 are pending.

Continued Prosecution Application

The request filed on January 30, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09485903 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 42 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase “chosen from copolymers of alkyl acrylate. . .and mixtures thereof” in claim 2 is vague and indefinite, as it is confusing. Does the term “copolymer” describe each component of the Markush group or does the term only describe the alkyl acrylate?

(ii) The phrase “chosen from hair” in claims 42 (line 2) and 45 (line 2) is vague and indefinite, as it is confusing. Is not hair a single entity or is Applicant claiming different types of hair? This rejection could be overcome by replacing the phrase “chosen from hair” with the phrase “hair”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 18-21, 24-30, 39-40 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Feder et al. (5,721,026).

Feder et al. teach aqueous silicone/copolymer dispersions crosslinkable into an elastomeric state. Disclosed is a composition comprising an oil-in-water base emulsion of an alpha, omega-(dihydroxy)polydiorganosiloxane stabilized with a surfactant, an aqueous latex of an organic copolymer, a cross-linking agent, a filler, and a metal curing catalyst. The organic monomers are selected from alkyl(meth)acrylates, unsaturated esters of monocarboxylic acids, vinylaromatic compounds, and others. The composition is disclosed for cosmetic use for the treatment of hair. See Example 1, Table 1; Col. 1, line 10-Col.7, line 54; Col. 11, line 6-Col. 24, line 56.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 22-23, 31-38, 40, 41 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feder et al. in view of Dubief et al. (6,024,946) and in view of Blankenburg et al. (6,153,179) or Audousset et al. (6,106,577).

Feder et al. is disclosed as discussed above. The reference fails to teach preferred polymer particles, propellants, a hair setting lotion, and a process of rinsing the hair.

Dubief et al. teach a composition for the treatment of keratinous materials consisting essentially of in an aqueous medium, at least one silicone, at least one latex consisting of a colloidal suspension of polymer particles insoluble in said aqueous medium, and at least one suspension agent for the silicone and the latex and/or at least one thickening agent. Specifically disclosed is a non-rinsed conditioner comprising an o/w emulsion of acrylamide/sodium 2-methyl propanesulfonate acrylamide copolymer, a latex of vinyl acetate/acrylic ester copolymer, and a mixture of octamethylcyclotetrasiloxane dimethiconol and dodecamethylcyclopentasiloxane. The silicones comprise 0.1-50% of the composition and the polymer particles comprise 3.1-10% of the composition. Propellants are disclosed as additives. A hairsetting lotion is disclosed as a form of the composition and a process of using the lotion is disclosed. See Col. 1, line 25-Col. 14, line 32.

Blankenburg et al. teach hair setting lotions comprised of a nonionic or anionic homo or copolymers of at least 70% by weight of N-vinylcaprolactam and a film-forming polymer. T-butyl acrylate/ethyl acrylate/methacrylic acid is disclosed as a film forming polymer. The hair

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setting lotion is disclosed as a hairspray comprising propane, butane, dimethyl ether, nitrogen, nitrous oxide or carbon dioxide as propellants. See Col. 1, line 11-Col. 4, line 35.

Audousset et al. teach the use of a composition containing a film-forming polymer aqueous dispersion and non-melanic pigment for temporarily dyeing hair. Film-forming polymers disclosed include (meth)acrylic acid/ethyl acrylate/ methyl methacrylate terpolymers and methyl methacrylate/butyl acrylate/ hydroxyethyl methacrylate/methacrylic acid tetrapolymers. It is disclosed that the aqueous dispersions of the polymers may be in the form of a latex. Silicones are disclosed as adjuvants for use in the composition. See Col. 1, line 6-Col. 10, line 49.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Dubief et al. into the invention of Feder et al. and obtain a hair-setting lotion and a process of using it because a) both references teach cosmetic compositions comprising an aqueous dispersion of insoluble polymer particles and at least one non-aminated silicone alpha, omega disilanol; b) Feder et al. teach his composition for the treatment of hair, especially with permanent waving to create a porous elastomeric film on the strands of the hair and Dubief et al. teach his composition as a hair-setting lotion to be used before or after perming; thus, since Feder et al. and Dubief et al. both teach compositions comprising the same active constituents for the treatment of hair one would expect the two compositions to exhibit similar properties; hence, teaching the composition of Feder et al. as the hair-setting lotion of Dubief et al. for cosmetic purposes would be within the skill of one in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the film-forming polymers of Blankenburg et al. or Audousset et al. for the organic copolymers of Feder et al. and obtain a composition comprising the insoluble polymer particles of claims 22 and 23 because a) all three references teach cosmetic compositions for the treatment of hair; b) Audousset et al. and Feder et al. both teach their polymers in aqueous dispersions and as a latex; c) the polymers of Blankenburg et al. and Audousset et al. are comprised of the monomers of Feder et al. used to make the organic copolymers; d) Audousset et al. teach that compositions comprising his film-forming polymers are particularly stable; e) Blankenburg et al. teach his composition as having good setting properties, good washing-out ability, low stickiness and the ability to form clear films; hence, the replacement of the film-forming polymers of Blankenburg et al. or Audousset et al. for the organic copolymers of Feder et al. would be within the skill of one in the art.

The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103.

Unexpected Results

It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

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In the instant case, the data on pages 17-23 of the specification have been considered but not found persuasive because a) the data merely demonstrates the effectiveness of the instant composition as a hair lotion, which is seen to be an expected result based on the prior art; and b) the data sets forth a side by side comparison of the instant composition with two other similar compositions, but fails to compare and contrast the properties of the instant compositions with the compositions of similar make-up.

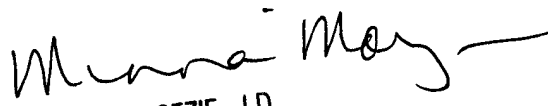
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
February 27, 2002


MINNA MOEZIE, J.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600